

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Appl. No.	:	10/671,924	Confirmation No. 8482
Appellant	:	Andrew S. Poulsen	
Filed	:	09/24/2003	
TC/A.U.	:	2476	
Examiner	:	Moutaouakil, Mounir	
Docket No.	:	10021064-01	

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF

Table of Contents

Section:

Table of Contents	i
Real Party in Interest	2
Related Appeals and Interferences.....	3
Status of Claims.....	4
Status of Amendments	5
Summary of Claimed Subject Matter	6
Grounds of Rejection to be Reviewed on Appeal	7
Argument	8
Claims Appendix.....	A-1
Evidence Appendix	B-1
Related Proceedings Appendix.....	C-1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appl. No. : 10/671,924 Confirmation No. 8482
Appellant : Andrew S. Poulsen
Filed : 09/24/2003
TC/A.U. : 2476
Examiner : Moutaouakil, Mounir

Docket No. : 10021064-01

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF

Dear Sir:

This Appeal Brief is submitted in response to the Examiner's Final Office Action
mailed October 28, 2009.

Appellants filed a Notice of Appeal on January 28, 2010.

Real Party in Interest

The real party in interest is Agilent Technologies, Inc., assignee of the above captioned patent application. Agilent Technologies, Inc. is a Delaware Corporation having its principal place of business in Santa Clara, California.

Related Appeals and Interferences

There are no related appeals and/or interferences.

Status of Claims

Claims 1-12 and 14-25 remain pending, all of which stand rejected. The rejections of these claims are hereby appealed.

Claim 13 has been canceled.

A copy of the claims which are the subject of this appeal is attached as a Claims Appendix to this Appeal Brief.

Status of Amendments

No amendments were made to the claims subsequent to final rejection. All amendments have been entered.

Summary of Claimed Subject Matter

In one embodiment (claim 1), an instrument system (100, FIG. 1; p. 5, lines 3-14) comprises an electronic test instrument (105, FIG. 1; p. 5, lines 6-14 & 27-29) and a network interface module (110, FIG. 1; p. 5, lines 10-26). The network interface module has a first connector (115, FIG. 1; p. 5, lines 11-15) for connecting with the electronic test instrument, a second connector (125, FIG. 1; p. 5, lines 15-21) for connecting with a voice module (120, FIG. 1; p. 5, line 30 - p. 6, line 7; p. 6, line 23 - p. 7, line 1), and a third connector (135, FIG. 1; p. 5, lines 21-26) for connecting with a network (130, FIG. 1; p. 6, lines 13-14). The network interface module and the electronic test instrument are configured to interchange instrument data via the first connector (p. 5, lines 14-15). The network interface module and the voice module are configured to interchange voice data via the second connector (p. 5, lines 15-16), wherein the voice data is in the form of an electronic signal (p. 6, lines 24-27). The network interface module and the network are configured to interchange combined voice and instrument data via the third connector (p. 5, lines 24-26; p. 7 lines 1-5). The network interface module is configured to effect transposition between combined voice and instrument data and separated instrument data and voice data (p. 7, lines 1-5).

Grounds of Rejection to be Reviewed on Appeal

1. Whether claims 1-12 and 14-25 should be rejected under 35 USC 112, first paragraph, as failing to comply with the enablement requirement.
2. Whether claims 1-12 and 14-24 should be rejected under 35 USC 103(a) as being unpatentable over Loveland (US Patent No. 6,782,413).
3. Whether claim 25 should be rejected under 35 USC 103(a) as being unpatentable over Loveland (US Patent No. 6,782,413) in view of Lashley et al. (US Patent No. 7,003,085; hereinafter "Lashley").

Argument

1. Claims 1-12 and 14-25 should not be rejected under 35 USC 112, first paragraph, as failing to comply with the enablement requirement.

The Examiner asserts that the specification does not contain sufficient information to enable the recitation of "an electronic test instrument". The Examiner further states:

... The specification does not explain what is the test instrument, what does the test instrument do, what is being tested, how does the test instrument generate the instrument data, what is the purpose [of] the test instrument and who will benefit from the tests generated.

10/28/2009 Final Office Action, p. 2.

[and]

... Applicant's original disclosure does not contain sufficient information to enable the broad scope of the claims.

10/28/2009 Final Office Action, p. 9.

To begin, appellant notes MPEP 2164.01, which states:

... The standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916) which postured the question: ***is the experimentation needed to practice the invention undue or unreasonable?*** That standard is still the one to be applied. *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). Accordingly, even though the statute does not use the term "undue experimentation," it has been interpreted to require that the claimed invention be enabled so that any person skilled in the art can make and use the invention without undue experimentation. *In re Wands*, 858 F.2d at 737, 8 USPQ2d at 1404 (Fed. Cir. 1988). See also *United States v. Electronics, Inc.*, 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988) ("The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation."). ***A patent need not teach, and preferably omits, what is well known in the art.*** *In re Buchner*, 929 F.2d 660, 661, 18

USPQ2d 1331, 1332 (Fed. Cir. 1991); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986), cert. denied, 480 U.S. 947 (1987); and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1463, 221 USPQ 481, 489 (Fed. Cir. 1984).

(Emphasis added)

In the present application, appellant believes it is clear that ***the invention*** is not a new kind of electronic test instrument *per se*, but rather an instrument system that comprises, in combination, an electronic test instrument and a network interface module having a particular relationship therebetween. Appellant's specification is replete with description of the electronic test instrument (see, e.g., p. 5, lines 3-7 & 27-29, and FIG. 1-5); how the electronic test instrument and network interface module are connected (p. 5, lines 10-15; p. 6, lines 3-5 & 15-22; p. 7, lines 6-8); how instrument data is passed therebetween (p. 7, lines 1-5; p. 9, lines 25-27; p. 10, lines 5-7); how voice and instrument data are combined and separated by the network interface module (p. 7, lines 1-5; p. 9, lines 19-24); how the network interface module can be used to obtain remote diagnostic and support help for the electronic test instrument (p. 7, lines 17-26); etc. In this context, appellant fails to understand how their specification would not ***enable*** one of ordinary skill in the art to make and use ***the invention***.

It is noted that the Examiner has not addressed any of the "undue experimentation factors" enumerated by *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). These factors are summarized in MPEP 2164.01(a) and include the following factors:

- (A) The breadth of the claims;
- (B) The nature of the invention;
- (C) The state of the prior art;
- (D) The level of one of ordinary skill;
- (E) The level of predictability in the art;

- (F) The amount of direction provided by the inventor;
- (G) The existence of working examples; and
- (H) The quantity of experimentation needed to make or use the invention based on the content of the disclosure.

In the instant case, and as previously noted, the Examiner has indicated that appellant's specification does not enable the broad scope of the claims. However, the Examiner has not articulated why or how appellant's claims are broader than what is enabled in their specification. Nor has the Examiner indicated what sort of undue experimentation is necessary to make or use appellant's supposedly broad "electronic test instrument".

Appellant readily admits that an electronic test instrument can assume various well known forms, and can be used for various well known purposes, all of which fall under the umbrella of the "electronic test instrument" recited in the claims. For example, an electronic test instrument can assume the form of a digital multimeter, an oscilloscope, a logic analyzer, or automated test equipment, to name a few. However, appellant notes that a particular form of electronic test instrument is not the focus or novelty of claim 1; and a patent need not teach, and preferably omits, what is well known in the art. See, *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991). Claims routinely recite such well known elements as screws, gears, hard disks, computers, wheels and so on; and unless an invention is directed to a particular kind of one of these elements, nothing more may be said about these elements because they are "well known". Similarly, electronic test instruments of various types are well known.

Of note, the determination that "undue experimentation" would have been needed to make and use the claimed invention is not a single, simple factual determination. Rather, it is a conclusion reached by weighing all the above noted factual considerations. *In re Wands*, 858 F.2d at 737. However, after considering the above Wands factors, appellant cannot identify even one factor that supports the Examiner's

assertion that the recitation of "an electronic test instrument" is not enabled.

With respect to the Examiner's specific questions regarding the claimed "electronic test instrument", appellant asserts that his electronic test instrument performs tests, which tests are useful to (or benefit) the operator or engineer that uses the electronic test instrument (see, e.g., p. 6, lines 8-9). However, contrary to the Examiner's assertions, appellant does not believe he needs to provide more detailed answers to the questions posed on page 2, par. 4, of the 10/28/2009 Final Office Action, because appellant's specification already enables one of ordinary skill in the art to make and use the "invention".

Reversal of the Examiner's rejections under 35 USC 112 is respectfully requested.

2. Claims 1-12 and 14-24 should not be rejected under 35 USC 103(a) as being unpatentable over Loveland (US Patent No. 6,782,413).

Claim 1 recites:

1. An instrument system, comprising:
an electronic test instrument; and
a network interface module having a first connector for connecting with the electronic test instrument, a second connector for connecting with a voice module, and a third connector for connecting with a network, wherein the network interface module and the electronic test instrument are configured to interchange instrument data via the first connector, wherein the network interface module and the voice module are configured to interchange voice data via the second connector, wherein the voice data is in the form of an electronic signal, wherein the network interface module and the network are configured to interchange combined voice and instrument data via the third connector, and wherein the network interface module is configured to effect transposition between combined voice and instrument data and separated instrument data and voice data.

With respect to claim 1, the Examiner asserts that Loveland discloses an "instrument system" in FIG. 2. See, 10/28/2009 Final Office Action, p. 3. However, appellant notes that Loveland does not indicate that any of the devices shown in FIG. 2

is an "instrument". And more particularly, Loveland does not describe any of the devices shown in FIG. 2 as an "electronic test instrument". In fact, the Examiner admits that Loveland fails to disclose any sort of "electronic test instrument". See, 10/28/2009 Final Office Action, p. 4. However, the Examiner takes "official notice" that it is well known that computers can test networks. See, 10/28/2009 Final Office Action, p. 4. Appellant agrees with both of the Examiner's latter statements. That is, appellant agrees that Loveland fails to disclose an electronic test instrument, and appellant agrees that it is well known that computers can test networks. However, appellant asserts that the Examiner has not made a case for why it would have been obvious to specially configure one of the general purpose computers disclosed by Loveland as an "electronic test instrument". Absent such a showing, appellant does not believe the Examiner has made a *prima facie* case for rejecting claim 1, and claim 1 is believed to be allowable.

In the Final Office Action mailed 10/28/2009, the Examiner responded to the above argument by 1) asserting that claims are to be interpreted broadly, and that limitations recited in the specification are not to be read into the claims, and 2) asserting that because appellant did not traverse the Examiner's "official notice that it is well known and preferred in the art the [sic] computers can test the network by sending packets, ping and traceroute commands to test the network [sic]", this well known information was taken as admitted prior art. See, 10/28/2009 Final Office Action, p. 10. Regarding the Examiner's first assertion, appellant fails to understand how this is relevant, because appellant has not argued that recitations in his specification be read into his claims. Instead, appellant has only urged that the phrase "electronic test equipment" be given meaning. The phrase "electronic test equipment" is *already in the claims*.

Regarding the Examiner's position that appellant failed to traverse the Examiner's "official notice that it is well known and preferred in the art the [sic] computers can test the network by sending packets, ping and traceroute commands to test the network [sic]", appellant readily admits that computers can be used to test networks. Appellant has never contested this. Appellant has, however, noted that the Examiner has never

made a case for why it would have been obvious to a PHOSITA to specially configure one of the general purpose computers disclosed in Loveland as an "electronic test instrument". The Examiner has not provided even one reason to support his assertion that specially configuring one of Loveland's general purpose computers as an "electronic test instrument" would have been obvious to one of ordinary skill in the art at the time of appellant's invention. Although the Examiner claims to have provided a reason, the reason is nothing more than this: because Loveland's general purpose computers exist, and because computers that test networks exist, it would have been obvious to replace one of Loveland's computers with a specially configured computer that is configured to test a network. However, such a conclusory statement of obviousness, based on the mere existence of piecemeal elements of a claim, is not sufficient to support an obviousness rejection.

MPEP 2141 indicates that an Examiner must support an obviousness determination by first determining the scope and content of the prior art, then ascertaining the differences between the claimed invention and the prior art, then resolving the level of ordinary skill in the art, and finally by providing a "rationale" to support a rejection under 35 USC 103. MPEP 2141.III states, in part:

The key to supporting any rejection under 35 U.S.C. 103 is the *clear articulation of the reason(s)* why the claimed invention would have been obvious. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Court quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), stated that "[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396.

(Emphasis added)

In the present context, the Examiner has not made explicit (or even implicit) any sort of rationale (or reason) as to why a PHOSITA would have found it obvious to

replace or reconfigure one of Loveland's computing devices 130 as a "test instrument". As such, the Examiner has not established a *prima facie* case of obviousness, and the burden of establishing otherwise has not shifted to appellant. However, despite appellant believing that he does not yet bear the burden of rebutting the Examiner's *prima facie* case (which case has not yet been made), appellant notes that Loveland makes no mention of "test" or "testing".

Not only has the Examiner failed to articulate a reason for why it would have been obvious to specially configure one of Loveland's general purpose computers as an electronic test instrument, but the Examiner has not shown that such a combination would work. And, assuming for a moment that such a combination could be made and would work, the Examiner has not made a case for why it would have been obvious to combine any sort of "instrument data" coming from one of Loveland's reconfigured computers with "voice data" coming from one of Loveland's phones. For example, given the different priorities and purposes of instrument data and voice data, there is no indication that one of ordinary skill in the art would have thought to combine them for transmission over a network (versus halting the transmission of voice data during the transmission of instrument data, or vice versa).

Appellant asserts that, by stating in a conclusory way that it would have been obvious to specially configure one of Loveland's computers as an electronic test instrument, the Examiner glosses over many of the considerations that one of ordinary skill in the art would have taken into account, which considerations might have turned one of ordinary skill in the art away from specially reconfiguring one of Loveland's computers, and at the very least, would not have made the reconfiguration of one of Loveland's general purpose computers "obvious".

To the extent the Examiner has taken official notice of the obviousness to replace or reconfigure one of Loveland's computers 130 as an electronic test instrument, *and then* combine instrument data from the electronic test instrument with voice data, appellant traverses this official notice and asserts that such a combination would not

have been well known at the time of appellant's invention.

Claim 1 is believed to be allowable for at least the above reasons.

Claims 2-10, 14-16 and 18-23 are believed to be allowable, at least, because each of these claims ultimately depends from claim 1.

Claims 5 and 10 are believed to be further allowable over claim 1. More specifically, Loveland does not teach a voice module that is built into the chassis of an electronic test instrument. At best, Loveland discloses 1) a computing device 130 that receives data, and 2) a separate telephone 137 that receives voice data. In response to the Examiner's assertion that building a voice module into the chassis of an electronic test instrument is simply "a matter of design choice" and has no particular purpose, appellant asserts that one purpose is to better integrate remote on-line support for the instrument (see, e.g., p. 6, lines 4-12, of appellant's specification).

3. Claim 25 should not be rejected under 35 USC 103(a) as being unpatentable over Loveland (US Patent No. 6,782,413) in view of Lashley et al. (US Patent No. 7,003,085; hereinafter "Lashley").

Claim 25 is believed to be allowable, at least, for reasons similar to why claim 1 is believed to be allowable, and because Lashley fails to disclose that which is missing from Loveland.

4. Conclusion

In summary, the art of record does not teach nor suggest the subject matter of appellant's claims 1-12 and 14-25. These claims are therefore believed to be allowable.

Respectfully submitted,
HOLLAND & HART, LLP

By: /Gregory W. Osterloft/
Gregory W. Osterloft
Reg. No. 36,232
Tel: (303) 295-8205

Claims Appendix

1. An instrument system, comprising:
 - an electronic test instrument; and
 - a network interface module having a first connector for connecting with the electronic test instrument, a second connector for connecting with a voice module, and a third connector for connecting with a network, wherein the network interface module and the electronic test instrument are configured to interchange instrument data via the first connector, wherein the network interface module and the voice module are configured to interchange voice data via the second connector, wherein the voice data is in the form of an electronic signal, wherein the network interface module and the network are configured to interchange combined voice and instrument data via the third connector, and wherein the network interface module is configured to effect transposition between combined voice and instrument data and separated instrument data and voice data.
2. The instrument system as recited in claim 1, wherein interchange of instrument data between the network interface module and the electronic test instrument comprises the reception of instrument data from the electronic test instrument by the network interface module.
3. The instrument system as recited in claim 1, wherein interchange of instrument

data between the network interface module and the electronic test instrument comprises the transmission of instrument data from the network interface module to the electronic test instrument.

4. The instrument system as recited in claim 1, wherein interchange of voice data between the network interface module and the voice module comprises the reception of voice data from the voice module by the network interface module.

5. The instrument system as recited in claim 4, further comprising the voice module, wherein the electronic test instrument comprises a chassis, wherein the voice module is built into the chassis, wherein the voice module comprises a transducer, and wherein the transducer transforms the human voice into electronic voice data.

6. The instrument system as recited in claim 1, wherein interchange of voice data between the network interface module and the voice module comprises the transmission of voice data from the network interface module to the voice module.

7. The instrument system as recited in claim 6, further comprising the voice module, wherein the voice module comprises a transducer, wherein the transducer transforms electronic voice data into sounds replicating the human voice.

8. The instrument system as recited in claim 1, wherein interchange of combined

voice and instrument data between the network interface module and the network comprises the reception of a data stream comprising combined instrument data and voice-over-IP data from the network by the network interface module and wherein the network interface module transposes the combined instrument data and voice-over-IP data into separated instrument data and voice data.

9. The instrument system as recited in claim 1, wherein the network interface module transposes separated instrument data and voice data into combined instrument and voice-over-IP data and wherein interchange of combined voice and instrument data between the network interface module and the network comprises the transmission of a data stream comprising the combined instrument and voice-over-IP data from the network interface module to the network.

10. The instrument system as recited in claim 1, wherein the system includes the voice module, wherein the electronic test instrument comprises a chassis, and wherein the voice module is built into the chassis.

11. The instrument system as recited in claim 1, further comprising the voice module, wherein the voice module is physically attached to the electronic test instrument.

12. The instrument system as recited in claim 11, wherein the transducer is a speaker.

14. The instrument system as recited in claim 10, wherein the voice module comprises a handset, wherein the handset is used for communication with an operator.
15. The instrument system as recited in claim 10, wherein the voice module comprises a headset, wherein the headset is used for communication with an operator.
16. The instrument system as recited in claim 10, wherein the voice module comprises a speaker, wherein the speaker is used for communication with an operator.
17. The instrument system as recited in claim 1, wherein the network interface module is physically attached to the electronic test instrument.
18. The instrument system as recited in claim 1, wherein the network is a local area network (LAN).
19. The instrument system as recited in claim 1, wherein the network is the internet.
20. The instrument system as recited in claim 1, wherein the network is a Wide-Area-Network.
21. The instrument system as recited in claim 1, wherein the system enables communication between the electronic test instrument and a remote system.

22. The instrument system as recited in claim 1, wherein the system enables communication between an operator located with the electronic test instrument and another individual located remote from the operator's location.
23. The instrument system as recited in claim 21, wherein diagnostic instrument data from the electronic test instrument is transmitted to a remote data analysis instrument.
24. The instrument system as recited in claim 21, wherein the third connector provides a wireless connection to the network.
25. The instrument system as recited in claim 1, wherein the electronic test instrument comprises a call button, the call button providing an operator of the electronic test instrument a mechanism to automatically connect to a support location, via the network interface module, to receive support help for the electronic test instrument.

Evidence Appendix

None.

Related Proceedings Appendix

None.